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OFFICE OF PETITIONS

In re Application of
Nadeau, et al.
Application No. 10/796,661
Filed: March 8, 2004
Attorney Docket No. P-4756D4

: DECISION ON PETITION
: UNDER 37 CFR 1.78(a)(3)
:
:

This is a decision on the petition under 37 CFR 1.78(a)(3), filed November 15, 2004, to accept an unintentionally delayed claim under 35 U.S.C. § 120 for the benefit of the prior-filed nonprovisional application set forth in the concurrently filed informal amendment.

The petition is **DISMISSED**.

A petition for acceptance of a claim for late priority under 37 CFR 1.78(a)(3) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after the expiration of the period specified in 37 CFR 1.78(a)(2)(ii). In addition, the petition under 37 CFR 1.78(a)(3) must be accompanied by:

- (1) the reference required by 35 U.S.C. § 120 and 37 CFR 1.78(a)(2)(i) of the prior-filed application, unless previously submitted;
- (2) the surcharge set forth in § 1.17(t); and
- (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2)(ii) and the date the claim was filed was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional.

The instant petition does not comply with item (1).

Petitioner is informed that Office records shows that application no. 09/894,796 became abandoned on December 3, 2003 for failure to respond to an Office action mailed on September 2, 2003. The present application, no. 10/796,661, was filed on March 8, 2004. There appears to be no copendency between application nos. 09/894,796 and 10/796,661.

Therefore, it would be improper to grant a petition adding a benefit claim that depends on application no. 09/894,796, even if petitioner had filed a formal amendment to the specification (petitioner has not). Application no. 09/894,796 is a necessary intermediate application between the instant application and application no. 09/590,061.

Petitioner must first file a petition to revive under 37 CFR 1.137(b) in application no. 09/894,796 in order to establish copendency between application no. 09/894,796 and the instant application.

Then petitioner must file a reconsideration petition under 37 CFR 1.78(a)(3) in the instant application with a formal amendment to the first line of the specification referencing both application no. 09/894,796, filed June 28, 2001 and application no. 09/590,061, filed June 8, 2000, indicating the relationship between each nonprovisional application in order to establish copendency throughout the entire chain of applications. In addition, it is noted that application no. 09/590, 061 matured into patent no. 6,316,200, not patent no. 6,379,888 as is stated in the petition.

37 CFR 1.78(a)(2)(i) requires that any nonprovisional application claiming the benefit of one or more prior-filed copending nonprovisional applications must contain or be amended to contain a reference to each such prior-filed application, identifying it by application number (consisting of the series code and serial number) and indicating the relationship of the applications. The relationship between the applications is whether the subject application is a continuation, divisional, or continuation-in-part of a prior-filed nonprovisional application. Also, the status of each nonprovisional parent application (if it is patented or abandoned) should also be indicated, following the filing date of the parent nonprovisional application. See MPEP Section 201.11, Rev. 2; May 2004, Reference to Prior Application.

Before any reconsideration petition under 37 CFR § 1.78(a)(3) can be granted, copendency between application no. 09/894,796 and application no. 10/796,661 must be established and then a renewed petition under 37 CFR § 1.78(a)(3) in application no. 10/796,661 and a substitute formal amendment (complying with 37 CFR 1.121) stating the relationship between each nonprovisional application in the chain is required.

Pursuant to petitioner's authorization, deposit account no. 02-1666 will be charged the required surcharge of \$1,370.00, which was the amount due on November 15, 2004.

Further correspondence with respect to this matter should be addressed as follows:

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By FAX after 7/15/05: (571) 273-8300 - ATTN: Office of Petitions

Any questions concerning this matter may be directed to Petitions Attorney E. Shirene Willis at (571) 272-3230.

A handwritten signature in cursive script that reads "Frances Hicks".

Frances Hicks
Lead Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy